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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,626	01/03/2002	Troy L. Bartlett	271901-1030	6773

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EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,626

Applicant(s)

BARTLETT ET AL.

Examiner

Sathyanarayan Pannala

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's Amendment filed on 01/24/2005 has been entered with new claims 21-40 and cancelled claims 1-20. Claims 21-40 are pending in this Office Action.

Specification

2. The amended abstract of the disclosure is objected to because it contains new matter not defined in the specification. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The terms "related information" and "alert condition" are not defined in the specification in order to determine a basis for the information.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 21-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "related information" and "alert condition" are not defined in the specification in order to determine a basis for the information.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 31-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Because paper is considered as one of the computer readable medium, which is considered as a non-tangible computer readable medium.

As per independent claim 31, the preamble recited as "A computer readable medium" as drafted said claim is not technologically embodied to a computer, whereas it is a non-tangible readable medium embodied to computer (See *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP

2106 IV 2(b), even though said claim is limited to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2nd at 1602 (Fed Cir. 1998); *AT&T Corp. V. Excel*, 50 USPQ 2nd 1447, 1452 (Fed. Cir. 1999).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 21,23-24, 26, 28-29, 31, 33-34, 36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent 6,336,142) hereinafter Kato and in view of Cheng et al. (US Patent 5,884,324) hereinafter Cheng.

11. As per independent claims 21, 26, 31 and 36, Kato teaches a method capable of executing different application programs such as Personal Information Manager (PIM) software, a web browser and an apparatus that has an infrared communication function for exchanging data with an external device such as a Personal digital assistant (PDA) (col. 1, lines 12-18). Kato teaches the claimed step of "selecting a data item in the personal information manager data for related information to be acquired" as a primary use of a PDA is to manage and browse personal information or PIM data, such as a calendar, a schedule (col. 2, lines 11-14). Further, Kato teaches the claimed step of "acquiring the related information for the data item" as PDA can directly acquire an HTML file from a web server (col. 2, lines 20-24). Kato teaches the transmission of data is an analogous (Kato, col.2, lines 44-49). However, Cheng explicitly teaches the claimed step of "providing the related information for the data item to the user" as the replication agent transmitting the data to the remote client (Cheng, Fig. 2A, col. 3, lines 65-66). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Cheng's teachings would have allowed Kato's method to provide communication link for clients to interact with a replication server in an asynchronous, disconnected mode (Cheng, col. 1, lines 60-67).

12. As per dependent claims 23, 28, 33 and 38, Cheng teaches the claimed step of "determining a device type of a remote device of the user and formatting the related information provided to the remote device" (Fig. 2A, col. 3, line 64 to col. 4, line 1).

13. As per dependent claims 24, 29, 34 and 39, Kato teaches the claimed step of "related information is selected from the group consisting of map data, weather data, flight data, hotel data, taxi data, and rental car data" as PIM data, such as a calendar, a schedule and address book (col. 2, lines 11-14).

14. Claims 22, 27, 32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent 6,336,142) hereinafter Kato, in view of Cheng et al. (US Patent 5,884,324) hereinafter Cheng and further in view of Green et al. (US Patent 5,794,242) hereinafter Green.

15. As per dependent claims 22, 27, 32 and 37, Kato and Cheng do not explicitly teach computing differences between two documents. However, Green teaches "computing differences between the related information and previously provided related information, and providing the differences between the related information and previously related information to the user" (Fig. 3, col. 3, lines 48-52). Thus it would have been obvious to one of ordinary skill in the art of data processing, at the time of the present invention, to combine the teachings of the cited references because the databases synchronization of Green's method would have provided Kao's with necessary procedure, which would allow quicker way to identify data modifications (col. 2, lines 1-2).

16. Claims 25, 30, 35 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent 6,336,142) hereinafter Kato, in view of Cheng

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et al. (US Patent 5,884,324) hereinafter Cheng and further in view of Hertzog et al.

(USA Pub. 2002/0194207A1) hereinafter Hertzog.

17. As per dependent claims 25, 30, 35 and 40, Kato and Cheng do not explicitly teach sending an alert message. However, Hertzog teaches the claimed step of "sending an alert to the user if a alert condition occurs for the related information" (page 19, paragraph [0207]). Thus it would have been obvious to one of ordinary skill in the art of data processing, at the time of the present invention, to combine the teachings of the cited references because the databases synchronization of Hertzog's method would have provided Kato's with necessary procedure, which would allow owner of the personal information is responsible for maintenance and any changes in the address book is viewable by other users of the service (Hertzog, page 1, paragraph [0005]).

Response to Arguments

18. Applicant's arguments with respect to claims 21-40 have been considered but are moot in view of the new ground(s) of rejection.

a) Applicants' amended the Abstract by adding new subject matter. So, Examiner objected the specification, See MPEP § 608.01(b).

b) Applicants' amended claims also have new subject matter and not supported by current specification. Examiner rejected claims 21-40 under 37 USC 112 first and second paragraphs.

- c) Applicants' amended claims 21-40 are rejected with by adding a prior art in addition the existing references on record.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sathyanarayan Pannala
Examiner
Art Unit 2167

srp
April 25, 2005


DIANA ROBINSON
PRIMARY EXAMINER